

REMARKS

Reconsideration of this application is respectfully requested in view of the following remarks.

Claims 1-29 were pending in this Application. In the Office Action:

- Claims 8-11 and 29 were rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,686,214 to Antaki, et al. ("Antaki").
- Claims 1-7 were allowed (though the Office Action mentions claims 1-9).
- Claims 12-28 were withdrawn from consideration by the Examiner.

Allowed Claims

Applicants thank the Examiner for the indication of allowed claims. While the body of the Office Action indicates that claims 1-9 are allowed, it appears from the cover sheet of the Office Action and from the rejection under 35 U.S.C. § 102(e) that the Examiner intended to designate only claims 1-7 as being allowed. If this is not what the Examiner intended, the Examiner is cordially invited to telephone Applicants' undersigned counsel to resolve any misunderstanding.

Rejection of Claim 29 Under 35 U.S.C. § 102(e)

Claim 29 was rejected under 35 U.S.C. 102(e) as being anticipated by Antaki. Applicants respectfully traverse that rejection.

The rejection of claim 29 mentions nothing more than the features expressly recited in claim 29. Nothing in the rejection of claim 29 addresses the combination of features incorporated into claim 29 by virtue of its dependency from claim 1. *See e.g.* 35 U.S.C. § 112, ¶ 4. It appears that the rejection may have been based on a mistaken belief that claim 29 depends from one of claims 8-11.

Claim 29, however, depends from claim 1. Claim 29 therefore is construed to include the combination of features that the Examiner indicated to be allowable in claim 1, in addition to the features expressly recited in claim 29. Claim 29 therefore is allowable for at least the same reasons as claim 1. Applicants respectfully request withdrawal of the rejection of claim 29.

Rejection of Claims 8-11 Under 35 U.S.C. 102(e)

Claims 8-11 were rejected under 35 U.S.C. 102(e) as being anticipated by Antaki. Applicants respectfully traverse the rejection of claims 8-11.

A finding of anticipation requires that *each* and *every* feature recited in the claim be found in the prior art. Antaki, however, fails to teach or suggest one or more of the features recited in claims 8-11. The rejection of claims 8-11 therefore should be withdrawn.

Claim 8

According to the rejection of claim 8:

Antaki teaches a method of preparing a substrate comprising: providing on a surface of the substrate a plurality of alignment markers, each of said plurality of alignment markers having a different orientation relative to a crystal axis of the substrate, wherein, for each of said plurality of alignment markers, a distance between an apparent position of the marker and an actual position of an element of the marker is dependent on the orientation of the marker. (abstract).

The rejection of claim 8 is based solely on Antaki's abstract. The abstract, however, fails to teach the combination of features recited in claim 8. The rejection of claim 8 therefore should be withdrawn.

Claim 8 recites a method of preparing a substrate. The method comprises providing a plurality of alignment markers on a surface of the substrate. Each of the alignment markers has a different orientation relative to a crystal axis of the substrate. *For each* of the plurality

of alignment markers, a distance between an apparent position of the marker and an actual position of an element of the marker is dependent on the orientation of the marker. (emphasis added)

The cited abstract of Antaki fails to disclose the foregoing combination of features recited in claim 8. For example, Antaki is silent as to the recited feature of providing a plurality of alignment markers in such a way that the *distance between an apparent position of the marker and an actual position of an element of the marker is dependent on the orientation* of the marker. Nor does Antaki teach this feature in combination with the other features recited in claim 8. Antaki therefore fails to anticipate claim 8.

Dependent Claims 9-11

The rejection of claims 9-11 is purportedly based on Antaki's abstract and Antaki's Figure 3 and/or column 3, lines 38-68 & column 4, lines 1-11. None of the cited portions of Antaki teaches the foregoing combination of features recited in claim 8. Inasmuch as each of claims 9-11 incorporates that combination of features by virtue of its dependency from claim 8, it is respectfully submitted that claims 9-11 patentably distinguish over the teachings of Antaki for at least the same reasons as claim 8. The rejection of claims 9-11 therefore should be withdrawn.

Examiner Initials on Form PTO-1449

Information Disclosure Statements (IDS) were filed for this application on May 16, 2005 and December 1, 2003. Each IDS included a respective Form PTO-1449. Applicants' counsel received a copy of the May 16, 2005 Form PTO-1449. However, the Examiner had not initialed a portion of the form which cites a European Search Report. Nor has Applicants' counsel received an Examiner-initialed copy of the December 1, 2003 Form PTO-1449.

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Applicants respectfully request that fully initialed copies of both Forms PTO-1449 be returned to Applicants' counsel to confirm the Examiner's consideration of each cited item.

See M.P.E.P. § 609.

In view of the foregoing all of the claims in this case are believed to be in condition for allowance. Should the Examiner have any questions or determine that any further action is desirable to place this application in even better condition for issue, the Examiner is encouraged to telephone Applicants' undersigned representative at the number listed below.

Date: January 25, 2007 By:



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